## REMARKS

***Introduction***

Claims 1-8 were originally pending in this application. Claim 7 has been cancelled and claim 9 has been added such that claims 1 – 6, 8, and 9 remain pending for consideration in this application.

***Claim Rejections***

**35 U.S.C. § 112**

Claims 7 – 8 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, by containing subject matter that was not described in the specification. More specifically, the Examiner stated that in claim 7, the term "band shaped" is not described in the specification. Further, the Examiner stated that in claim 8, the term "sonic ring" is not described in the specification. Accordingly, claim 7 has been cancelled and claim 8 has been amended to correct a typographical error in which the term "sonic ring" was corrected to read "sonic horn" as found in the specification. Therefore, the applicants respectfully submit that the claims as currently amended now comply with the standards of 35 U.S.C. § 112.

**35 U.S.C. §103**

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,108,147 to Grimm et al. in view of U.S. Patent No. 6,124,886 to DeLine et al. Claims 2 – 5 and 7 – 8 were similarly rejected as being unpatentable over the Grimm and DeLine references as applied to claim 1 and in further view of U.S. Patent No. 4,618,516 to Sager. Claim 6 was also rejected as being unpatentable over Grimm, DeLine, and Sager as applied to claim 2 and further in view of U.S.

Patent No. 4,231,609 to Sorensen. The applicants cannot agree with the Examiner that the invention claimed would have been obvious to one of ordinary skill in the art in view of these references. Accordingly, for the reason set forth below, the applicants respectfully traverse these rejections.

***The Prior Art***

**U.S. Patent Nos. 5,108,147 to Grimm et al. and 6,124,886 to DeLine et al.**

The Grimm '147 patent is directed toward a ***device for fastening a headliner to the roof frame of a roof structure***. Specifically, Grimm et al. discloses an "S-shaped" clip device 10 that has a lower groove 11 that slides onto and securely attaches the clip device 10 to a portion of the roof frame 4 of a vehicle. The "S-shape" of the clip device 10 further provides an inwardly extending upper groove 18 that cooperates with a bendable upper edge strip 17 of a specifically constructed headliner 13 to secure the headliner 13 to the roof frame 4. More particularly, the portion of the headliner that surrounds the open roof frame area 2 has an upwardly directed bent edge 14. The upwardly bent edge 14 of the headliner 13 also has an upper edge strip 17 that is formed having a bending notch 15 that allows the upper edge strip 17 to be bent back over the horizontal portion of the headliner 13. The bending notch 15 allows the upper edge strip 17 to be bent back and inserted into and securely retained by the upper groove 18 of the clip device 10. In this manner, the Grimm '147 patent provides a clip device for use with a particular headliner construction to physically clip the headliner directly to the roof frame of the vehicle. However, ***it does not concern itself with a method of securing a separate trim piece to the headliner***.

The DeLine '886 patent is directed toward a ***device that provides a modular rearview mirror assembly incorporating one or more integrated modules***. The modules include a variety of electronic sensors, detectors, displays, controllers, and the like, so that many functional devices are

incorporated into the body of the singular rearview mirror assembly. Beyond the complexity of the various devices incorporated into this device, the Examiner notes that in the construction of the DeLine '886 rearview mirror assembly, the bezel 284 of the mirror assembly 270 may be secured to the case 272 by ultrasonic welding. Thus, while the DeLine '886 patent provides a complex rearview mirror that may utilize ultrasonic welding in its assembly, ***it does not concern itself with a method of securing a separate trim piece to the headliner***.

Neither the Grimm et al. nor the DeLine et al. patents disclose or suggest a ***method of installing a trim ring to a headliner*** of a motor vehicle that includes the steps of stacking a sonic horn with the headliner and the trim ring; and vibrating the sonic horn such that the trim ring and the headliner bond and weld together in at least one weld area as required by independent claim 1.

**U.S. Patent No. 4,618,516 to Sager**

The Sager '516 patent is directed to a method of ultrasonic welding of thermoplastic workpieces. Specifically, the Sager '516 patent discloses three examples of a first workpiece 10 having energy directors 18 in contact with a specific rough surface 20 on a second workpiece 12 that assist in faster dissipation of the ultrasonic energy from the first to the second workpiece 12. This provides more efficient thermoplastic welding with lower ultrasonic energy. The Sager '516 process is directed to all ultrasonic thermoplastic welding operations, is not application specific, nor does it disclose any methods of how to apply ultrasonic energy to the weld area. Thus, the Sager '516 patent does not disclose or suggest a method of installing a trim ring to a headliner of a motor vehicle that includes the steps of stacking a sonic horn with the headliner and the trim ring; and vibrating the sonic horn such that the trim ring and the headliner bond and weld together in at least one weld area as required by independent claim 1.

**U.S. Patent No. 4,231,609 to Sorensen**

The Sorensen '609 patent is directed to a vehicle sunroof frame. Specifically, Sorensen is cited as having a trim ring 50 that serves as a fastener that secures the frame 20 of the sunroof to the vehicle roof 14. Secondarily, the trim 50 has a bottom flange 60 that provides support for the headliners 16 at its edge about the sunroof opening. However, it is respectfully submitted that Sorensen does not provide a method of securing a trim ring to a headliner and is entirely distinct from the other prior art references as well as the method of the present invention.

In summary, none of the prior art references of record in this case disclose or suggest the method of installing a trim ring to a headliner of a motor vehicle as described in independent claim 1.

***The Present Invention***

In contrast to the prior art references, the present invention as defined in independent claim 1 is a method of installing a trim ring to a headliner of a motor vehicle that includes the steps of stacking a sonic horn with the headliner and the trim ring; and vibrating the sonic horn such that the trim ring and the headliner bond and weld together in at least one weld area.

***Argument***

A rejection based on §103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of an analysis under § 103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q.

(BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed. Cir. 1985). The relevant analysis invokes a cornerstone principle of patent law:

> That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).
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> A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. American Hoist & Derek Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

As the Court of Appeals for the Federal Circuit noted, "[w]hen a rejection depends upon a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." Ecolochem, Inc. v. Southern Calif. Edison, 56 U.S.P.Q. 2d 1065, 1073 (Fed. Cir. 2000). Here, there is simply no motivation provided in either of the Grimm et al., or DeLine et al. references to combine their teachings. Furthermore, even assuming that such a motivation existed, a combination of these references would not result in the method of installing a trim ring to a headliner of a motor vehicle as described in independent claim 1.

It is respectfully submitted that the apparatuses of the Grimm et al. and DeLine et al. references skirt around, but do not suggest the claimed invention ***as a whole***. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383 (Fed. Cir. 1986). Further, it is respectfully submitted that even if these apparatus references did make such a suggestion, one must pick and choose elements from the dissimilar disclosures in the Grimm et al. and DeLine et al. references, combine these elements by restructuring, using hindsight and the applicants' own disclosure, to first

suggest a method, then conclude that the claimed method is obvious. The applicants respectfully submit that this would be improper in view of the disclosure of the prior art.

The Grimm et al. patent is directed to a device for fastening a headliner to the roof frame of a roof structure. Specifically, the Grimm '147 patent provides a clip device for use with a particular headliner construction to physically clip the headliner directly to the roof frame of the vehicle. It does not concern itself with a method of securing a separate trim piece to the headliner as defined in independent claim 1.

On the other hand, the DeLine '886 patent is directed toward a device that provides a complex rearview mirror assembly that may utilize ultrasonic welding in its construction. It does not concern itself with a method of securing a separate trim piece to a vehicle headliner as defined in independent claim 1.

In short, the applicants respectfully submit that there is no motivation to combine these references. Furthermore, even if the devices of the Grimm et al. and DeLine et al. references were combined, they would fail to teach the method of the present invention as defined in independent claim 1.

In addition, neither the Sager '516 patent nor the Sorensen '609 patent make up for the deficiencies in the teachings of the Grimm et al. or DeLine et al. references. Thus, it is respectfully submitted that independent claim 1 recites a method that is not disclosed or suggested by the prior art and is patentably distinguishable from the subject matter of the references discussed above. Claims 2 through 9 are all ultimately dependant upon independent claim 1 and add further perfecting limitations. As such, the prior art references in combination or each reference standing alone do not suggest the present invention. However, even if they did, they could only be applied through hindsight after rearranging the disclosure of the prior art in view of applicants' invention. A

combination of the prior art in this way to derive applicants' invention would, in and of itself, be an invention.

***Conclusion***

In view of the above, the applicants respectfully submit that the claims are clearly distinguished over the prior art and are therefore allowable. Accordingly, applicants respectfully solicit the allowance of the claims pending in this case.

Respectfully submitted,

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